

## II. Rejections Under 35 U.S.C. § 103(a)

The Office has maintained the rejection of claims 43-62 and 64-67 under 35 U.S.C. § 103 (a) as being unpatentable over EPA 590,604 ("EP '604") in view of U.S. Patent No. 4,878,604 ("Sramek") and Chemical Abstract 89:117546 ("the '546 abstract"), for the reasons set forth at pages 2-3 of the outstanding Final Office Action. Applicant respectfully traverses this rejection for the reasons of record, as well as for the following additional reasons.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See M.P.E.P. § 2143.01.* The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *Id.*

The Federal Circuit does not take the requirement for motivation lightly, stating that "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of ... motivation. ...The showing must be clear and particular." *[emphasis added]* *See In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999) (abrogated on other grounds).

In more recent cases, the Federal Circuit has held that determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence." *See In re*

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*Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless "substantial evidence" found in the record supports the factual determinations central to the issue of patentability, the rejection is improper and should be withdrawn. *See Zurko*, 258 F.3d at 1386.

On January 18, 2002, the Federal Circuit again reaffirmed the Office's high burden to establish a *prima facie* case of obviousness. Specifically, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (internal quotations and citations omitted).

In the Final Office Action dated April 1, 2002, the Office maintained that "[i]t would have been obvious to one of ordinary skill to add the polymer of '604 to the composition of Sramek to impart freeze-thaw resistance and to use the polymer of '546 as a hair setting polymer in view of its high effectiveness *[sic]* and water resistance." *See* Final Office Action, page 3. However, a close reading of the references reveals that the Examiner has failed to provide the requisite "thorough and searching" analysis required to determine whether the teachings of the three applied references should be combined. Instead, the Examiner has ignored the majority of the teachings of the applied references, including teachings which suggest that the references should not likely be combined, in order to haphazardly pluck Applicant's claimed polymer

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ingredients from a multitude of possible polymers known in the art and combine them without any suggestion to do so.

In the present case, the Office has relied upon EP '604 to teach an acrylates copolymer. See Final Office Action, page 2. The Office has relied upon the '546 abstract to teach acrylates/hydroxyesters acrylates copolymers. *Id.* However, neither of these references teach or suggest Applicant's claimed ingredients in combination. In fact, both EP '604 and the '546 abstract teach hairspray compositions where copolymers are used separately, without another polymer resin. See, e.g., EP '604, Examples 19-35, and the '546 abstract, second to the last sentence. Neither EP '604 nor the '546 abstract provide any suggestion for using these separately disclosed copolymers with another polymer resin.

A close reading of Sramek reveals that it does not provide the missing motivation to combine resins. Rather, Sramek is directed to a hair setting composition comprising a hair setting resin, a solvent for the resin, and an amine containing neutralizing agent. See, e.g., column 3, lines 52-58. A large number of possible resins are taught, including resins chosen from anionic polymers, acrylic polymers, and amphoteric polymers. See column 4, line 44, to column 5, line 58. All of these resins are taught separately, and in fact, most of the examples are directed to single resin compositions. See, e.g., columns 12-14, Examples 1-22. Thus Sramek does not require that any two of the large number of resins which are separately taught necessarily be combined.

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together. Further, Sramek does not teach either of Applicant's claimed copolymers. Since Sramek provides little or no motivation for combining the multitude of polymer resins it teaches, it certainly does not provide motivation for combining the specific polymers disclosed by EP '604 and the '546 abstract.

Rather, one of ordinary skill in the art, looking at Sramek, EP '604, and the '546 abstract in combination would likely choose a single resin hairspray composition, because single resin compositions are taught by all three references. Thus, looking at the references as a whole, there would not have been the clear and particular motivation necessary to establish a *prima facie* case of obviousness.

The Office has continued to argue that the EP '604 and Sramek references teach water in overlapping amounts, and that the EP '604 reference teaches up to 80% VOC. See Final Office Action, page 3, second and third paragraphs. However, for the reasons pointed out previously on the record, EP '604 is drawn to improvement of aqueous-based polymer compositions, while Sramek, on the other hand, teaches hairspray resins which are dissolved in hydrocarbon solvents, such as ethanol and isopropanol, and advises using the minimum amount of water. See Response filed December 19, 2001. These differences between Sramek and EP '604 further undermine the inadequate motivation provided by the Office.

The Office has attempted to piece together motivation by citing certain disclosed advantages of the separately disclosed polymers. See Final Office Action, page 3, first paragraph. However, as the Office is well aware, the references must be considered in

their entirety, i.e., as a whole. *See* M.P.E.P. § 2141.02. As discussed above, a thorough and searching inquiry of the Sramek, EP '604, and the '546 abstract references, taken as a whole, reveals that these references merely teach a large number of resins used separately in hairspray compositions. In light of these teachings, the Office's piecemeal motivational statements fail to provide adequate factual evidence necessary to show clear and particular motivation. Accordingly, no *prima facie* case of obviousness has been established.

### III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 3, 2003

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